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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/909,075	07/18/2001	Mamoru Kosakai	SUMI-006	9765

7590

07/18/2003

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EXAMINER

MAYEKAR, KISHOR

ART UNIT

PAPER NUMBER

1753

DATE MAILED: 07/18/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/909,075

Applicant(s)  
M. KOSAKAI et al.

Examiner  
Kishor Mayekar

Art Unit  
1753



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jun 30, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Jul 18, 2001 is/are a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some\* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

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## DETAILED ACTION

### *Drawings*

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the power supply electrode must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### *Specification*

2. The abstract of the disclosure is objected to because it is not within the range of 50-150 words. Correction is required. See MPEP § 608.01(b).

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3. The disclosure is objected to because of the phrase "In addition, Electrostatic adsorption apparatus" with "Electrostatic" starting with a capital letter.

Appropriate correction is required.

4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

*Claim Rejections - 35 USC § 112*

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 1-6 are rejected under 35 U.S.C. 112, first paragraph, as containing

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subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The independent claim 1 recites a power supply electrode that applies a voltage to the electrode as well as the specification discloses in the 3rd paragraph of page 7 that the apparatus 10 is equipped with power supply electrode 7, however it is not clear to the skill in the art as to how the recited or disclosed electrode can apply a voltage to the electrostatic adsorption electrode. Clarification is needed.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-3 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the phrases "the adsorption surface" and "the plastic film"

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are lacking antecedent basis. The phrase "that applies" is indefinite for its reference to a method of operating the device.

Regarding claim 2, the phrase "employs" is indefinite for its reference to a method of operating the device.

Regarding claim 3, the phrase "the positive electrode" is lacking antecedent basis when it depends upon claim 1.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over

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HONMA et al. (5,748,436) in view of JP 07-297265, a reference cited by Applicant. HONMA's invention is directed to an electrostatic chuck for electrostatically clamping a working member to the chuck. HONMA discloses in Fig. 3 that the chuck comprises an electrostatic adsorption electrode, an insulated dielectric layer covered the electrostatic adsorption electrode, and a power supply. The differences between HONMA and the above claims are the setting of the recited roughness of the adsorption surface of the dielectric layer, and the intended use of the chuck.

As to the first subject matter, JP '265 shows in an electrostatic chuck the setting of roughness on the adsorption surface of the dielectric layer to be  $0.25\text{ }\mu\text{m}$  or below which is within the recited range (see abstract). The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified HONMA's teachings as suggested by JP '265 because this would result in obtaining an electrostatic chuck having a quick response characteristic and an excellent performance.

As to the intended use, the use of the chuck for processing plastic film, the subject matter as a whole would have been obvious to one having ordinary skill in the

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art at the time the invention was made to have modified the references' teachings because it has been held on the intended use of apparatus that "apparatus claims cover what a device is, not what a device does", *Hewlett-Packard Co. V. Bausch & Lomb Inc.*, 15 USPQ 2d 1525.

As to the subject matter of claim 3, the recited ratio of the interval and the thickness, the selection would be within the level of ordinary skill in the art.

As to the subject matter of claim 4, 5 or 6, the recited volumetric resistivity of the dielectric layer, HONMA further discloses that the dielectric layer has an electrical resistivity between  $10^8$  to  $10^{13} \Omega \text{ cm}$  which overlaps the recited range.

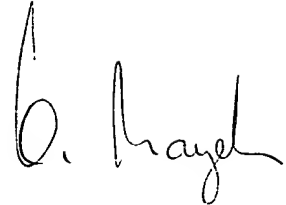
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (703) 308-0477. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen, can be reached on (703) 308-3322. The fax phone number for this Group is (703) 872-9310 (non-after finals) or 872-9311 (after final).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



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A handwritten signature in black ink, appearing to read 'K. Mayekar', with a stylized, cursive script.

Kishor Mayekar  
Primary Examiner  
Group 1700

KM  
July 14, 2003